REMARKS

This Amendment constitutes Applicants' Submission Accompanying Request for Continued Examination in the above-identified application.

Claims 1-11 were present in this application as of the time of the issuance of the currently outstanding Final Official Action. By the foregoing Amendment, Claims 1, 10 and 11 have been amended. Claim 2 was previously cancelled, without prejudice, as being redundant in view of the amended Claim 1. Applicants do not propose the cancellation of any claims or the addition of any new claims in this Amendment. Accordingly, upon the entry of the foregoing Amendment, Claims 1 and 3-11 as hereinabove amended will constitute the claims under active prosecution in this application.

The claims of this application showing the changes made by this Amendment are shown above as required by the Rules.

More specifically, it is noted that in an Advisory Action dated 22 October 2004, the Examiner refused to enter Applicants' Amendment After Final Rejection Under 37 CFR 1.116. The Examiner's stated reasons for his refusal to enter Applicants' Amendment After Final Rejection Under 37 CFR 1.116 were that:

> The proposed amendments raise new issues that would require further consideration and/or search. For example, the limitations of a "a polyolefin-type polymer film characterized by a first type of film index ellipsoid...a polyolefin-type polymer film characterized by a film index ellipsoid of a different type from said first type of film index ellipsoid...". And, the limitation "...change into said first type of film index ellipsoid by SAID STRETCHING" would require further consideration under 35 USC 112.

Further, in the currently outstanding Final Official Action, the Examiner has:

1. Acknowledged Applicants' claim for foreign priority under 35 USC 119(a)-(d) or (f), and indicated that the required certified copies of the priority document have been received by the United States Patent and Trademark Office.

2. Acknowledged Applicants' Information Disclosure Statements as filed on 23 October 2003 and 16 March 2004 by providing Applicants with a copy of the Forms PTO-1449 that accompanied those Statements duly signed, dated and initialed by the Examiner to confirm his consideration of the art disclosed therein, however, Applicants Information Disclosure Statements of 22 January 2004 and 18 August 2004 remain unacknowledged - **acknowledgement of the latter two Information Disclosure Statements in response to this communication is respectfully requested;**

3. The drawings as filed on 8 January 2001 were previously accepted by the Examiner;

4. Rejected Claims 1 and 3-11 under 35 USC 103(a) as being unpatentable over the Kay, et al reference (U.S. Patent 5,444,143) in view of the Nakao et al reference (U.S. Patent No. 6,272,097), and further in view of the Mori, et al. reference (U.S. Patent No. 4,400,062); and

5. Provided Applicants with a Notice of References Cited (Form PTO-892) along with a copy of the newly cited Mori reference.

Further comment in these Remarks regarding items 1-3 and 5 above is not considered to be necessary in these Remarks.

With regard to item 4, Applicants again respectfully note that in response to their previous Amendment the Examiner has indicated:

> But Kaye et al in combination with Nakao et al does not expressly disclose that the compensation film comprises a uniaxially-stretched or biaxially-stretched polyolefin polymer film.
> However, this feature is well known in the art as evidenced by Mori et al, which discloses compensation element included in the pathways of the optical elements of an optical pickup comprising a compensation film of a ***serving a uniaxially-stretched or biaxially-stretched polyolefin-type polymer film function*** of changing polarization state of the laser beam...
> Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to include a compensation film of a high polymer film in order to effectively ***obtain the function*** of changing polarization state of the laser beam entering to the optical storage medium which can easily, inexpensively mass produced and also can easily be integrally formed ***and stackable*** as suggested by Mori et al. (Emphasis added)

By the foregoing amendment (as previously submitted in their Amendment After Final Rejection Under 37 CFR 1.116), Applicants proposed that the independent claims of this application (i.e., Claims 1, 10 and 11) be amended so as to specifically include:

> "said transparent optical compensation film (i) comprising a polyolefin-type polymer film characterized by a first type of film index ellipsoid, said polyolefin-type polymer film characterized by said first type of film index ellipsoid having been formed by uniaxially stretching or biaxially stretching a polyolefin-type polymer film characterized by a film index ellipsoid of a different type from said first type of film index ellipsoid such that said different type of film index ellipsoid is changed into said first type of film index ellipsoid by said stretching".

The Examiner, as noted above, refused to enter that amendment because of an asserted need for further consideration and/or search concerning the latter wording based upon 35 USC 112 (presumably, the adequacy of the support in the specification as filed for the foregoing language).

In this regard, Applicants note that in the Amendment After Final Rejection Under 37 CFR 1.116 it was pointed out that the proposed amendment was fully supported at least at page 8, lines 24-25 of the present specification. In further support of that position, Applicants respectfully call the Examiner's attention to Figure 12 of the present application referred to at page 25 of the present specification, and to page 5, lines 16-31, wherein it is stated that:

> An example of the above-mentioned optical compensation film is a high polymer film subjected to stretching so as to change the polarization state of the laser beam. More specifically, the optical compensation film according to the present invention can be formed by subjecting to plastic forming such as uniaxial stretching or biaxial stretching a high polymer of polyolefin-type that is even ***and has little deformation***. Moreover, the present optical compensation film has a prescribed birefringence distribution. The polymer member having an even molecular orientation with a birefringence that is at most 10 nm is subjected to high accuracy stretching operation in the uniaxial or biaxial direction, thereby causing displacement of the molecular orientation, which results in the optical film attaining optical anisotropy. ***Fig. 12 shows the models of index ellipsoids before and after the stretching operation.*** If planar refractive index is represented by nx, ny, and the refractive index in the thickness direction is represented by nz, $nx > ny \geq nz$ would be established for the optical compensation film formed by stretching of a normal film.

Hence, it will be understood that the specification clearly and definitely supports the amended wording of the claims. Specifically, the polyolefin-type film characterized by a first type of film index ellipsoid is the result of uniaxial or biaxial stretching of a polyolefin-type film of a different type film index ellipsoid. In the words of the specification, the starting film "is even and has little deformation", i.e., has a birefringence no greater than about 10 nm.

Thus, the starting film index ellipsoid disclosed in the exemplary specification disclosure has a zero or minor film index ellipsoid – the "different film index ellipsoid". That starting film index ellipsoid is converted into the claimed first film index ellipsoid by the uniaxial or biaxial stretching claimed. Thus, there can be no doubt that the wording of the foregoing amended claims is fully supported by the present specification and drawings as originally filed. A decision so holding in response to this submission is respectfully requested.

In addition, Applicants respectfully note that the Examiner himself has recognized that the structure of the so-called "compensation film" of the Mori reference is different from that of the present invention. Specifically, the Mori, et al. "compensation film" that the Examiner has characterized as a "compensation film" ***serving the function*** of the herein claimed uniaxially-stretched or biaxially-stretched polyolefin-type film is actually ***a pair of stacked or overlapped***, high molecular films (such as polypropylene) that have been cut from the same sheet. The Mori reference indicates that the sheet from which his films are cut might have been stretched during manufacture on an elongation roll, but clearly does not disclose, teach or suggest that a polyolefin-type polymer film can be used alone (i.e., without overlapping or stacking multiple film sheets) as a compensation film after uniaxial or biaxial stretching. In other words, the Mori reference does not disclose, teach or suggest that a polyolefin-type polymer film can be made to function as a wave plate by uniaxial or biaxial stretching.

The foregoing amendment makes it clear that only a single polyolefin-type polymer film is contemplated by the present invention, not the stacked structure proposed by Mori, et al. Further, by specifying that the polyolefin-type polymer film claimed is a film wherein the original film ellipsoid type has been changed into a different film ellipsoid type by uniaxial or biaxial stretching, Applicants respectfully submit that the foregoing proposed amendment clearly and definitely removes any possible ambiguity concerning whether or not the film presently claimed is, or could be, the same as the manufactured film prior to subsequent stretching discussed in the Mori, et al reference.

In addition, Applicants respectfully note that since the direction(s) of stretch applied to the polyolefin-type polymer film are known and controlled in the present invention, the determination of the optical axis of the film is easier thereby facilitating the process of attachment the polyolefin-type polymer film to the integrated unit.

Consequently, as previously argued, since (i) none of the cited references discloses, teaches or suggests a transparent optical compensation film comprising a uniaxially-stretched or biaxially-stretched polyolefin-type polymer film as herein claimed, and (ii) the Examiner has conceded that none of the references alone disclose the present invention by virtue of his withdrawal of his previous anticipation rejection, Applicants respectfully submit that Claims 1, 10 and 11 as hereinabove amended, as well as the claims remaining after the foregoing Amendment that depend either directly or indirectly from Claim 1, are in condition for allowance.

More specifically, Applicants respectfully note that by employing a non-stacked transparent optical compensation film structure as now specifically claimed as a wave plate, it is possible to convert the incoming laser beam into a circularly polarized light or an elliptically polarized light and also to readily attach the transparent optical film to the optical components of the claimed. Applicants respectfully submit that none of the cited references either alone or in combination with one another disclose, teach or suggest the present invention as now claimed within their "four corners" as would be required to sustain the Examiner's burden of showing a *prima facie* case of the obviousness of the claimed invention. To the extent that the Examiner's currently outstanding rejection is supported, therefore, Applicants respectfully submit that it, like the previous rejection, applies an improper "obvious to try" standard, and should be withdrawn.

The correct standards necessary to support a conclusion (*prima facie* case) of obviousness are as follows:

> To establish a *prima facie* case of obviousness under Section 103, Title 35 United States Code (35 US §103), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2D 1438 (Fed. Cir. 1991). (See, Manual of Patent Examining Procedure §2142 (8th Edition), at page 2100-2121, *et seq.*)

Applicants respectfully submit that not only do the references not disclose the transparent optical compensation film now claimed, but also that any suggestion for the use of such a film in the context of the present invention in the present record is to be found only in the present specification, not in the cited art.

Further, also as indicated previously, Applicants presently rely upon the patentability of the independent claims as support for the patentability of the dependent claims of this application. Accordingly, since Applicants respectfully submit that Claims 1, 10 and 11 as hereinabove amended are patentable for the reasons set forth, it is respectfully submitted that Claims 3-9 also are patentable. Further specific discussion concerning the Examiner's rejections of Claims 3-9, therefore, is not considered to be required in these Remarks.

For each and all of the foregoing reasons, it is respectfully submitted that the claims of this application as they will stand upon the entry to the foregoing Amendment are in condition for allowance. Further, it is respectfully submitted that the foregoing proposed amendment simply clarifies the nature of the claimed transparent optical compensation film by the incorporation of descriptive material from the specification confirming the heretofore implicit meaning that the claimed transparent optical compensation film is not an overlapped or stacked structure.

Entry of the foregoing amendment, reconsideration of this application, and allowance of Claims 1 and 3-11 as hereinabove amended in response to this communication, therefore, are respectfully requested.

Finally, Applicants believe that additional fees are not required in connection with the consideration of this response to the currently outstanding Official Action. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge and/or credit Deposit Account No. **04-1105**, as necessary, for the correct payment of all fees which may be due in connection with the filing and consideration of this communication.

Respectfully submitted,

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